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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,753	05/14/1999	TSUYOSHI INOUE	Q54370	1662

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WASHINGTON, DC 20037

EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/311,753

Applicant(s)

INOUE ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Comments***

2. Applicants' unsigned declaration has been reviewed for content but has not been officially considered since it is currently unsigned. See response to arguments section below for a discussion of the declaration as it pertains to the rejection of record.

### ***Request for Continued Examination***

3. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on December 22, 2003 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al. ('751 A) in view of the general state of the art as taught by any one of Arakawa et al. (JP '528 A), Müssig ('353 B1) or Matsui et al. (EP '354 A2). See English translation of JP '751 A and the Machine translation of JP '528 A.

Regarding claim 2, Miyahara et al. disclose a sheet which comprises a support comprising a polymer film (*Figure 1, layer 1b and Paragraph 0012*) laminated on one or both surfaces of a non-woven fabric (*layer 1a and Paragraphs 0009 - 0011*), and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric (*layer 2 and Paragraph 0015*), wherein said non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (*Paragraphs 0010 - 0011 and examples in Table – 70 g/m<sup>2</sup>*) and said polymer film comprises a thermoplastic polymer (*JPO Abstract and Constitution; Figure 1; and Paragraphs 0007 – 0013 and 0019*). Miyahara et al. further disclose that the film can be used to adhere and protect metallic surfaces from corrosion due to water (*Abstract and Paragraph 0017*).

Miyahara et al. fail to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use thermoplastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles from debris, dirt, etc. during transport and delivery (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*). The Examiner notes that automobiles comprise metallic surfaces.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Miyahara et al. to be used as a

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method of protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint, and the Miyahara et al. invention would not only protect the paint films from debris and dirt, but would also protect any exposed metallic portions from corrosion due to water, etc.

Regarding claim 3, Miyahara et al. disclose a polymer film meeting applicants' claimed thickness limitations (*Paragraphs 0013 and 0019 and Examples 2 and 3 in Table 1*).

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seth ('964) in view of the general state of the art as taught by any one of Arakawa et al. ('528 A), Müssig ('353 B1) or Matsui et al. ('354 A2). See provided Abstract translations and Machine translations of JP '751 A and JP '528 A.

Regarding claim 2, Seth discloses a sheet which comprises a support comprising a polymer film (*Figure 3, layer 16 and col. 5, lines 7 - 37*) laminated on one or both surfaces of a non-woven fabric (*layer 14*), and a pressure-sensitive adhesive layer formed on one surface of said polymer film (*layer 18*) opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (*col. 2, lines 54 - 59*) and said polymer film comprises a thermoplastic polymer (*col. 5, lines 7 - 25 and col. 6, lines 35 - 64*).

While Seth teaches a preferred structure to prevent excessive removal of the non-woven fibers when the adhesive tape is removed from a roll (*col. 2, lines 60 – 65*) Seth fails to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use thermoplastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles from debris, dirt, etc. during transport and delivery (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Seth to be used as a method of protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint and using the film taught by Seth would allow the adhesive tape to be removed from its roll without excessive removal of the non-woven fibers.

Regarding claim 3, Seth further disclose a range in thickness overlapping applicants' claimed limitation. While Seth fails to disclose an embodiment meeting applicants' claimed limitations, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the thickness of the polypropylene backing layer through routine experimentation in the absence of a

showing of criticality in the claimed thickness, especially given the teaching in Seth regarding the overlapping range in thickness and the knowledge that the thickness of the film will effect the pliability and strength of the adhesive tape. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

### ***Response to Arguments***

#### **6. The rejection of claims 2 and 3 under 35 U.S.C § 103(a) – Miyahara et al. or Seth et al. in view of various references**

Applicant(s) argue(s) that the declaration provided by Mr. Tsuyoshi Inoue illustrates the unexpected superiority of the claimed invention over the prior art. The examiner respectfully disagrees.

The Examiner notes that the current declaration is unsigned, and therefore cannot be relied upon to distinguish over the prior art. However, with regard to the content of the declaration, the Examiner notes that applicants have presented evidence showing the alleged unexpected improvement in follow-up performance to curved surfaces, water permeability, peeling properties and adhesion strength. In so far as the arguments go with respect to any of these properties, applicants are reminded that the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). Presently the claims do not contain any limitations directed to these properties. Furthermore, the Examiner notes that the peeling properties and adhesion strength are known functions of the

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choice of adhesive and are not deemed "unexpected", since one of ordinary skill in the art would possess the knowledge to tailor the adhesive to the desired application. The rejections of record provide numerous references describing the use of "tapes" for protecting the paint films of automobiles, and one of ordinary skill would have known to use an adhesive that would be "peelable" to prevent damage to the paint when the film is removed.

However, with regard to the follow-up performance to curved surfaces and water permeability, the Examiner finds applicants' arguments convincing based on the data provided in the presently unsigned declaration. Specifically, the Examiner deems that claims directed to a protective sheet "wherein the protective sheet prevents water permeability when adhered to a curved surface" (*specification pages 3, 4, 14 and 15*) would distinguish over the prior art of record upon filing of an executed declaration.

### ***Conclusion***

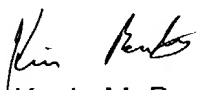
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin M. Bernatz  
Patent Examiner

February 18, 2004